

REMARKS/ARGUMENTS

This application has been carefully considered in connection with the Examiner's Action. Reconsideration and allowance are respectfully requested in view of the following.

Claims 1-16 and 21-22 have been canceled without prejudice or disclaimer. Claim 24 has been amended to correct an antecedent basis problem stemming from an improper dependency in the claim when originally presented. As the foregoing amendment merely cancels claims and/or corrects non-substantive errors in the claims, entry of this amendment is respectfully requested.

Claims 12-16 and 24 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter regarded as the invention. As to Claims 12-16, the Applicant respectfully submits that the cancellation of these claims renders the Examiner's rejection moot. As to Claim 24, a review of the claim indicated that an improper dependency inadvertently resulted in a lack of proper antecedent basis for the claim. By this amendment, the Applicant has amended Claim 24 to depend on Claim 17, thereby establishing proper antecedent basis for all of the limitations of Claim 24. Accordingly, the Applicant respectfully requests the reconsideration and withdrawal of the rejection of Claims 12-16 and 24 under the second paragraph of Section 112.

Claims 1, 2, 12, 13, 17 and 21-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,816,730 to Alspaw et al. Claims 3-8, 14-16 and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Alspaw et al. in view of U.S. Patent No. 4,149,738 to Illos et al. Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Alspaw et al. in view of U.S. Patent No. 5,947,522 to Boehm. Finally, Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Alspaw et al. in view of

Boehm and further in view of U.S. Patent No. 5,884,770 to Galm. In response, the Applicant respectfully traverses the various rejections of Claims 1-24 and instead submits that Claims 17-20 and 23-24, as above amended, are neither taught nor suggested by the art of record. Accordingly, the Applicant respectfully requests the reconsideration and withdrawal of the various rejections of Claims 1-24 and the allowance of Claims 17-20 and 23-24.

As above amended, Claims 17-20 and 23-24 are directed to a process for facilitating the reading skills of a pre-reader which is neither taught nor suggested by the cited art. In accordance with the process defined by Claim 17-20 and 23-24, a repetitive language kit, the repetitive language kit including, among other components, a plurality of pages, at least one having a photographic site configured to receive a pictorial representation and at least one having a caption site configured to receive repetitive text, is provided. An experience of the pre-reader is memorialized through pictorial representations. From the provided pages of the repetitive language kit, a subset of the pages, specifically, those pages suitable for memorialization of the experience in a repetitive language book, are selected for securement of the pictorial representations thereto. After securement of the pictorial representations related to the memorialized experience, the pictorial representations are personalized with text. The selected pages, with the affixed pictorial representations of memorialized experiences and personalized text, are then bound together to complete assembly of the repetitive language book. The aforementioned pages are then read to the pre-reader to facilitate the reading skills of the pre-reader.

The cited art has been carefully considered but neither teaches nor suggests Applicant's invention as defined in Claims 17-20 and 23-24. Heretofore, much of the prosecution of this application has focused on the issue as to whether printed matter which changed the nature of a

substrate from a page of a book to a page of a repetitive language book was functionally related to the substrate such that the printed matter may be used to patentably distinguish the invention over the prior art. While of continuing interest to the undersigned, the foregoing issue has been rendered moot in view of Applicant's cancellation of those claims directed to structures, specifically, the repetitive language kit of Claims 1-11 and 21-22 and the repetitive language book of Claims 12-16, which incorporated the printed matter at issue.

The sole issue remaining before the Examiner is whether the process for facilitating the reading skills of a pre-reader defined by Claims 17-20 and 23-24 is either taught or suggested by the cited art. As to this issue, it is respectfully submitted by the Applicant that such a process is neither taught nor suggested by the cited art. More specifically, in accordance with the claimed process for facilitating the reading skills of a pre-reader and contrary to the teachings of the cited art, a repetitive language kit containing a plurality of page and a binder is provided. From the plurality of pages contained in the repetitive language kit, a first subset of the plurality of pages, specifically, those pages which are suitable for memorialization, within the book, of an experience previously memorialized with pictorial representations, are selected. Implicit in the selection of those pages deemed suitable for memorialization of the experience is that a second subset of the plurality of pages, specifically, those pages deemed unsuitable for memorialization of the experience, are NOT selected and remain loose pages which continue to form part of the partially consumed kit. The selected pages, on the other hand, are bound together to form a repetitive text book for subsequent use in facilitating the reading skills of the pre-reader.

Regarding Claim 17:

The Examiner asserts that all of the limitations of Claim 17 may be found in Alspaw et al.

In this regard, the Examiner variously states that Alspaw et al. teaches:

- (1) "a binder (18) for securing selected ones of the plurality of pages proximate the binder edges;"
- (2) "binding the pages with the binder;" and
- (3) "selecting from the plurality of pages, pages suitable for memorialization of the experience."

Examiner's Action dated October 1, 2004, pg. 6, lines 4-9.

Regarding asserted teaching (1), Alspaw et al. discloses only a bound photographic collection book and neither teaches nor suggests Applicant's claimed step of selecting, from a plurality of pages contained in a repetitive text kit, certain pages to be included in a repetitive text book and then binding the selected pages to form the desired repetitive text book. The book resulting from performing the steps set forth in Applicant's Claim 17 would contain only the selected ones of the plurality of pages included in the kit while any unselected ones of the plurality of pages included in the kit would remain loose pages of the kit. By binding together a plurality of pages, certain ones of which are subsequently selected for securement of photographs thereto, it may be argued that the binder disclosed in Alspaw et al. secures the selected ones of the plurality of pages. However, such an argument does not take into account the clear meaning of Claim 17, specifically, that Applicant's binder, which is clearly capable of securing all of the plurality of pages (Claim 17, line 10) is used to secure only those pages which are selected for affixment of pictorial representations thereto (Claim 17, line 18). Such a limitation is neither taught nor

suggested by Alspaw et al.

Regarding asserted teaching (2), Alspaw et al. docs disclose that all the pages of the book are bound together by a binder. Here again, however, nowhere does Alspaw et al. teach or suggest those limitations of Claim 17 which recite that only those pages that were previously selected are bound together. In this regard, Applicant respectfully notes that the Examiner has merely asserted that the binder disclosed in Alspaw et al. is used for "binding the pages," a correct statement of the teachings of Alspaw et al. but not one that reads on the claimed step of "binding said selected pages." As used herein, the term "selected" clearly means those pages previously selected, from the plurality of pages provided in the repetitive language kit, as being suitable for memorialization of an experience of the pre-reader, a feature neither taught nor suggested by Alspaw et al.

Regarding asserted teaching (3), the Examiner's argument has again failed to appreciate the clear meaning of the claim when equating the teachings of Alspaw et al. to the limitations set forth in Claim 17. More specifically, the Examiner asserts that Alspaw et al. teaches "selecting, from the plurality of pages, pages suitable for memorialization of the experience." While the foregoing statement again represents a correct statement of the teachings of Alspaw et al., it does not read on the corresponding limitation of Claim 17 when that limitation is read in conjunction with the remaining steps of the claim. More specifically, Claim 17 is directed to a method of facilitating the reading skills of a pre-reader in which the repetitive text book produced by binding together selected ones of the pages provided in the repetitive language kit contains only those pages deemed suitable for the memorialization of the experience. In contrast, Alspaw et al. discloses a book in which pages deemed suitable for memorialization of an experience are selected after the book is bound together. As a result, any page deemed unsuitable for the memorialization of the experience

would remain in the book unused. In this manner, Applicant's claimed process for facilitating the reading skills of a pre-reader by reading, to the pre-reader, a book which contains only those pages relevant to a particular experience of the pre-reader is superior to a process in which a pre-reader would be read from a book containing both pages relevant to a particular experience of the pre-reader as well as pages irrelevant to the experience of the pre-reader.

Regarding Claim 20:

In rejecting Claim 20 as unpatentable over the combination of Alspaw et al. in view of Illos et al., the Examiner asserts that "it is inherent that the pages would be read to a pre-reader since the pre-reader is not capable of reading the pages to himself/herself." Examiner's Action dated October 1, 2004, page 9, lines 16-17. While the aforementioned limitations of independent Claim 17 patentably distinguish dependent Claim 20 over the cited art, the Applicant further submits that, in rejecting Claim 20, the Examiner has improperly relied upon the doctrine of inherency. More specifically, an inherency rejection may only be used when the recited structure and/or method may only function in the claimed manner. Here, Claim 20 further recites the step of "reading said pages [of the repetitive book] to the pre-reader." However, that is not the only use of a repetitive book. For example, the article "Just Think of the Possibilities: Formats for Reading Instruction in the Elementary Classroom" submitted by the applicant as an attachment to the amendment filed July 6, 2004 states at page 4, lines 31-32 that "children can easily learn and join in" the reading of a repetitive book--a process known in the art as "shared reading." Thus, as the pages of a repetitive book may be used in processes other than "reading the pages to a pre-reader", the rejection of Claim 20 as inherent to the combination of Alspaw et al. and Illos et al. is improper and should be withdrawn.

CONCLUDING REMARKS

The Applicant has disclosed and claims a process for facilitating the reading of a pre-reader which is neither taught nor suggested by the cited art. Accordingly, for the reasons set forth above, the Applicant respectfully requests the reconsideration and withdrawal of the various rejections of Claims 1-24, the allowance of Claims 17-20 and 23-24 and the passing of this application to issue.

This application is now in condition for allowance. A prompt Notice to that effect is, therefore, earnestly solicited.

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Respectfully submitted,



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